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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,545

08/21/2003

Douglas S. Hine

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EXAMINER

ALTER, ALYSSA MARGO

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

04/02/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/646,545	Applicant(s) HINE ET AL.	
	Examiner Alyssa M. Alter	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-13 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-13 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 11-13, and 16-22 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-6, 11-13, and 16-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,705,900. Although the conflicting claims are not identical, they are not patentably distinct from each other because both discloses a set of lead adapter with a first and second adapter that are integrally connected and placed within the bore of a medical device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-6, 11-13, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sommer et al. (6,705,900). Sommer et al. discloses an implantable medical device with a connector bore having one or more connector block portions along an inner surface and a single lead connector with a plurality of lead electrodes.

As to figure 6, Sommer et al. depicts a first adapter 252 and a second adapter 264 having external surfaces to engage the inner surface of the connective bore. In

addition the adapters have external conductive portions; 254 on the first adapter and 266 on the second adapter.

Additionally, "at least one of the electrical contact elements of the one or more electrical contact elements of the first adapter is located in a different location along the internal surface thereof than the one or more electrical contact elements of the second adapter". Since the second adapter 264 possesses electrically connective fingers 268 which engage the connector ring 255, and the connector ring and fingers are located in different location on the first adapter than on the second adapter, respectfully, the examiner considers Sommer et al. to meet this limitation.

As to claim 2, "the sleeve to be seated over the lead so that the dimensions of the assembly conform to a predetermined standard such as IS-1" (col. 9, lines 19-21).

As to claim 4-5, the sleeve includes external and internal sealing rings or protrusions.

As to claim 6, the two adapters are dimensioned to for a press fit or "snap-fit connection that provides both a mechanical and electrical coupling" (col. 9, lines 34-35).

As to claim 21, since the first adapter is configured to receive the second adapter, under edge 270, the examiner considers the diameter opening of the first adapter to be larger than the diameter of the second adapter.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

2. Claims 1-6, 11-13, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sommer et al. (6,921,295). Sommer et al. discloses an implantable medical device with a connector bore having one or more connector block portions along an inner surface and a single lead connector with a plurality of lead electrodes.

As to figure 6, Sommer et al. depicts a first adapter 252 and a second adapter 264 having external surfaces to engage the inner surface of the connective bore. In addition the adapters have external conductive portions; 254 on the first adapter and 266 on the second adapter.

Additionally, "at least one of the electrical contact elements of the one or more electrical contact elements of the first adapter is located in a different location along the internal surface thereof than the one or more electrical contact elements of the second adapter". Since the second adapter 264 possesses electrically connective fingers 268 which engage the connector ring 255, and the connector ring and fingers are located in different location on the first adapter than on the second adapter, respectfully, the examiner considers Sommer et al. to meet this limitation.

As to claim 2, "the sleeve to be seated over the lead so that the dimensions of the assembly conform to a predetermined standard such as IS-1" (col. 7, lines 30-31).

As to claim 4-5, the sleeve includes external and internal sealing rings or protrusions.

As to claim 6, the two adapters are dimensioned to for a press fit or “snap-fit connection that provides both a mechanical and electrical coupling” (col. 7, lines 43-44).

As to claim 21, since the first adapter is configured to receive the second adapter, under edge 270, the examiner considers the diameter opening of the first adapter to be larger than the diameter of the second adapter.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

3. Claims 1-6, 11-13, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Stein et al. (US 6,854,994). Stein et al. discloses an implantable medical device with a connector bore having one or more connector block portions along an inner surface and a single lead connector with a plurality of lead electrodes.

As to figure 6, Stein et al. depicts a first adapter 252 and a second adapter 264 having external surfaces to engage the inner surface of the connective bore. In addition the adapters have external conductive portions; 254 on the first adapter and 266 on the second adapter.

Additionally, “at least one of the electrical contact elements of the one or more electrical contact elements of the first adapter is located in a different location along the internal surface thereof than the one or more electrical contact elements of the second

adapter". Since the second adapter 264 possesses electrically connective fingers 268 which engage the connector ring 255, and the connector ring and fingers are located in different location on the first adapter than on the second adapter, respectfully, the examiner considers Stein et al. to meet this limitation.

As to claim 2, "the sleeve to be seated over the lead so that the dimensions of the assembly conform to a predetermined standard such as IS-1" (col. 10, lines 11-13).

As to claim 4-5, the sleeve includes external and internal sealing rings or protrusions.

As to claim 6, the two adapters are dimensioned to for a press fit or "snap-fit connection that provides both a mechanical and electrical coupling" (col. 10, lines 25-26).

As to claim 21, since the first adapter is configured to receive the second adapter, under edge 270, the examiner considers the diameter opening of the first adapter to be larger than the diameter of the second adapter.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim 22 is rejected under 35 U.S.C. 103(a) as being obvious over Sommer et al. (6,705,900), Sommer et al. (6,921,295) or Stein et al. (US 6,854,994). Sommer et al. and Stein et al. discloses the invention substantially as claimed except for a label on the surface of the first and second adapters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include labels on the external surfaces of the adapters in order to provide the predictable results of quick and easy identification of the kit components.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571)272-4939. The examiner can normally be reached on M-F 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/

Primary Examiner, Art Unit 3762

/Alyssa M Alter/
Examiner
Art Unit 3762